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EXAMINER

MANIWANG, JOSEPH R

| ART UNIT | PAPER NUMBER |
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2144

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,344

Applicant(s)

EJIRI, SEISHI

Examiner

Joseph R Maniwang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/733,493.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (U.S. Pat. No. 4,994,926), hereinafter referred to as Gordon, further in view of Marshall (U.S. Pat. No. 6,396,597), hereinafter referred to as Marshall.
3. Regarding claims 18-21, 28-31, and 38-41, Gordon disclosed a network of store and forward facilities (SAFF) for communicating fax data between a plurality of clients associated with the SAFF (see column 2, lines 49-66). The network for use in the disclosed invention was described in terms of a locally switched telephone network and a separate long distance network (see column 5, lines 12-30). In such a local network, a SAFF serviced a plurality of receiving fax machines associated with the SAFF through locally switched phone lines. The long distance network was reserved for communications where it was necessary to communicate to a fax machine that was not within the local network serviced by the same SAFF (see column 6, lines 47-59). In this way, it is similar to the network system claimed by the applicant, where there existed two separate lines of data communication, one of a LAN and another separate from the LAN. The SAFF served as both a transmission and a reception means for fax data over

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either of the networks (see column 6, lines 60-64). Gordon disclosed notification of received data to the intended recipients by the SAFF as claimed (see column 11, lines 18-26; column 12, lines 45-55). Gordon also disclosed use of a "Delivery Record" which served to notify the originating sender of the delivery of the fax data in the form of fax document. Such notifications occurred upon the delivery of the fax data to the intended client-machine (see column 8, lines 18-32). Gordon further disclosed the ability to accumulate such data to deliver as a single fax document, reporting the results of several delivery attempts. Such reports would be delivered "in bulk" in a single call (see column 9, lines 35-42; column 10, lines 46-49). Such a mode of notification delivery was disclosed as programmable by the originator SAFF (see column 9, lines 37-40), and Gordon further disclosed that a computer means controlling the SAFF allowed for user intervention in the sequence of automatic actions of the system (see column 5, lines 4-11). Thus, a selection means for such a mode as claimed was disclosed. Gordon also disclosed the ability to indicate a plurality of recipients for the same document (see column 1, lines 23-26; column 3, lines 48-62; column 14, lines 9-28).

4. Regarding claims 22-27, 32-37, and 42-47, Gordon disclosed a fax communications system substantially as detailed above. Most important is the disclosed possibility of transmitting a delivery record upon request by the originating sender. This involved a call generated by the transmission side and resulted in a status report for a given message (see column 9, lines 35-42, 53-60). Gordon further disclosed this ability as programmable (see column 9, lines 35-42), and that the disclosed computer means controlling the SAFF allowed for user intervention in the

sequence of automatic actions of the system (see column 5, lines 4-11). Thus, a selection means for such a mode as claimed was disclosed.

5. While Gordon disclosed the invention substantially as detailed above, Gordon did not disclose the use of a LAN as the local network between a SAFF and the client machines it serviced.

6. Marshall disclosed a network comprised of a plurality of client computers, a central server computer, and a fax "store-and-forward" (SAFF) server capable of receiving fax data to transmit to the networked client computers. See Abstract. Marshall disclosed the well-known use of computers for sending and receiving fax data (see column 1, lines 20-36). The use of LAN between networked computer systems was also disclosed as well known at the time (see column 1, lines 37-46). Much like the invention disclosed by Gordon, the SAFF received fax data from an outside source and transmitted it to the appropriate clients within the LAN.

7. Gordon disclosed a SAFF to provide service to fax machines across local networks (see column 5, lines 45-61). Gordon did not specifically mention the use of LAN as a local network, but stated that the term "network" broadly meant the system required to complete a communication between originator and answerer (see column 4, lines 60-65). In this way, Gordon does not limit the type of network suitable for use in his system, thus allowing for the possible use of a LAN. Marshall disclosed a fax server system similar to the system disclosed by Gordon, using a SAFF to provide service to user terminals on a local network (see column 2, lines 38-42). As Marshall disclosed the known use of computers as fax machines and the use of LAN between such

computers (see column 1, lines 20-46), it would have been obvious to modify the invention disclosed by Gordon to use computer terminals in the place of recipient fax machines, and to use LAN between the computer terminals. Marshall disclosed that the use of LAN had become the predominant way of connecting computers together (see column 1, lines 37-40), and the use of fax-compatible computers allowed for greater fax storage and transmission capabilities over a conventional fax machine (see column 1, lines 20-26), a problem which Gordon sought to overcome (see column 1, lines 43-51).

8. Claims 18-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teramura et al. ("Experimental Facsimile Communication System on Packet Switched Data Network", IEEE Transactions on Communications, Volume 29, Issue 12, Dec 1981), hereinafter referred to as Teramura, and further in view of Marshall (U.S. Pat. No. 6,396,597), hereinafter referred to as Marshall.

9. Regarding claims 18-21, 28-31, and 38-41, Teramura disclosed a fax communication system for communications between a public switched telephone network (PSTN) and a packet switched data network (PSDN). The system included a "facsimile communication processor" (FCP), which provided store-and-forward facilities for the networks (see page 1942, section I). Multiaddress delivery was also disclosed, where a sender could designate a plurality of recipients for a fax (see page 1946, section 2). The FCP was capable of notifying a sender of the status of a sent message in the form of a fax document (see page 1946, section 4). Notification was available in both delayed delivery and multiaddress delivery. The FCP informed the originating

sender of a fax message automatically concerning the destination terminal. As delayed delivery concerned a single recipient, it can be assumed that each notification indicated the results of the single recipient. In multiaddress delivery, a notification of accumulated transmission results was sent (see Fig. 7). Such notifications as seen in Fig. 7 represented either the success or failure of transmission. Selection between delayed delivery and multiaddress delivery was provided through the facility request command (FRC) signal, thus providing a selection means between how a notification would be received, dependent on the type of fax delivery requested.

10. Regarding claims 22-27, 32-37, and 42-47, Teramura disclosed the invention as detailed above. Teramura further stated the possibility of generating notifications automatically or upon request by the originating sender at any time (see page 1946-1947, section 4).

11. Teramura did not disclose the use of LAN, or a notification means for notifying recipients of data reception.

12. Marshall disclosed the invention as detailed above. Marshall disclosed the well-known use of computers for sending and receiving fax data (see column 1, lines 20-36), as well as the well-known use of LAN between networked computer systems (see column 1, lines 37-46). Marshall disclosed a store and forward capability much like the one disclosed by Teramura. Marshall also disclosed the ability to notify intended recipients of received fax messages (see Abstract).

13. Teramura disclosed a fax system with store and forward capabilities. Teramura taught the use of a PSDN which connected a plurality of fax machines (see Fig. 1), but

did not mention the use of LAN. Marshall disclosed a fax server system similar to the system disclosed by Teramura, using a SAFF to provide service to user terminals on a local network (see column 2, lines 38-42). Marshall disclosed the known use of computers as fax machines and the use of LAN between such computers (see column 1, lines 20-46). Therefore, it would have been obvious to modify the invention disclosed by Teramura to use computer terminals in the place of recipient fax machines and LAN between the computer terminals as both were well known elements in fax systems. Furthermore, as the SAFF disclosed by Marshall had the ability to notify recipient computers over the LAN of fax reception, it would have been obvious to include such a feature in the invention of Teramura if incorporating a LAN similar to the one disclosed by Marshall, which already included such a notification feature.

Response to Arguments

14. Amendment to the specification in response to objection to the specification for failing to recite U.S. Pat. No. 6,163,800 to which application claims priority to has been entered into record. This objection has been withdrawn.

15. Applicant's arguments filed 01/27/04 have been fully considered but they are not persuasive.

16. Regarding claims 18-21, 28-31, and 38-41, Applicant asserts that the references do not teach a first mode as claimed, wherein notification results for the receivers are transmitted one by one by plural-time communications. Applicant also states that both

modes involve transmission of information representing notification results relating to data designated to plural receivers. Examiner considers these arguments non-persuasive in light of the above rejections made under 35 U.S.C. 103(a). Examiner reiterates that Gordon disclosed the ability to indicate a plurality of recipients for the same document (see column 3, lines 48-62; column 14, lines 9-28). Teramura also disclosed plural recipients (see page 1946, section 2). Examiner also submits that Gordon taught a first mode as claimed, as it was disclosed that a "Delivery Record" which served to notify the originating sender of the delivery of the fax data occurred upon the delivery of the fax data to the intended client machine (see column 8, lines 18-32). Delivery of such reports were disclosed as being made through additional calls, or in other words, plural-time communications (see column 10, lines 41-56). Furthermore, Examiner submits that Gordon also taught of a second mode as claimed, where notification results could be collectively transmitted in a one-time communication (see column 9, lines 35-42; column 10, lines 46-49). Teramura also disclosed delivery of notification results for individual recipients, as well as accumulating notification results for plural recipients, as noted in the above rejections (see page 1946, section 4; Fig. 7).

17. Regarding claims 22-27, 32-37, and 42-47, Applicant asserts that the references do not teach the noted point (a) in the remarks which states "it is set whether the transmission of the information representing the notification results by the transmission means on the basis of the call generation from the data processing apparatus side is to be presented". Specifically, Applicant states that it is unclear in Gordon "as to the

transmission of information in response to which call based on what kind of standard".

The claims as amended relate generally to two modes of operation concerning the transmission of notification results. Examiner submits that Gordon disclosed such modes as claimed. As noted in the above rejection, Gordon disclosed transmitting a notification upon request by the originating sender, or in other words, transmission of information in response to a call generated by the transmission side, and further disclosed transmitting a notification based on calls made by the originator SAFF, or in other words, transmission of information in response to calls generated by the receiving side (see column 9, lines 35-60). Also noted in the above rejection is a setting means for such operating modes. The main issue noted by the Applicant is whether or not it is set that a notification will be transmitted based on a call generated by the data processing side, or in other words, allowing a SAFF to call the sender of a fax in order to transmit a notification. The ability to permit or disallow a SAFF to call the sender with a notification should be clear as Gordon also disclosed providing a subset of control setting/service features (see column 5, lines 4-30), making clear to one of ordinary skill that such an option could be permitted or omitted. Furthermore, Applicant asserts that the reasoning for not permitting a call from a SAFF is avoidance of an unintended call. Gordon recognized a similar problem, and offered as a solution a programmable option of accumulating and transmitting records upon request by a sender to reduce number of calls and burden on the sender (see column 9, lines 35-44).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gordon et al. (U.S. Pat. No. 5,459,584) disclosed a system of store and forward facilities for delivering fax messages in a network.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (703) 305-3179. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B Harvey can be reached on (703)305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER